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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,705	03/17/2004	Hans Peter Brack	GEPL.P-086-2	4827

43247 7590 12/14/2006
Marina Larson & Associates LLC
re: lexan
PO BOX 4928
DILLON, CO 80435

EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/802,705

Applicant(s)

BRACK ET AL.

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

- A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

The Status of Claims

Claims 1-13 are pending.

Claims 1-13 have been rejected.

DETAILED ACTION

Priority

1. It is noted that this application is a continuation of 10/027,139 (12/26/2001) ABN ,which claims benefit of 60/258,710 IP (12/28/2000).

Drawings

2. None.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

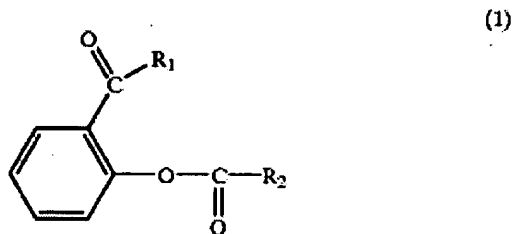
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-31 of copending Application No. 10/027,138. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between claim 1 of the instant invention and claim 13 of Application No. 10/027,138 are as follows:

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13. A process for the production of an aromatic polycarbonate, the process comprising adding to a polycarbonate oligomeric reaction mixture under melt conditions, which mixture comprises polycarbonate oligomer, a terminal blocking agent of the formula (1):



wherein R₁ is a methoxy, ethoxy, propoxy, butoxy, phenyl, phenoxy, benzyl or benzoxy; and R₂ is a C₁-C₃₀ alkyl group, C₁-C₃₀ alkoxy group, C₆-C₃₀ aryl group, C₇-C₃₀ aralkyl, or C₆-C₃₀ aryloxy group,

wherein the terminal blocking agent is added to the polycarbonate oligomer in a stoichiometric amount of about 0.1 to 6.5 relative to the free OH, and wherein the terminal blocking agent is added to the polycarbonate oligomer in a stoichiometric amount of about 0.1 to 1.5 relative to the free OH content of the polycarbonate oligomer, and wherein at least 80% of the total amount of the terminal blocking agent is added to the mixture after the polycarbonate oligomer has reached a number-average molecular weight Mn of about 2,500 to 15,000 Dalton.

The relationship between the Application No. 10/027,138 and the current invention is the genus and the species; for example, claim 13 which has the value of R₁ which is a methoxy, ethoxy, propoxy, butoxy, phenyl, etc is broader than that of the claim 1 of the instant invention which has only the value of R₁ which is a propoxy, butoxy.

The rest of the dependent claims are almost identical and therefore, do not distinguish the applications. The instantly claimed genus of R₁ is, thus, completely encompassed by that of the

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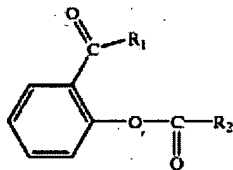
claim 1 of Application No. 10/027,138, thereby being obvious over that of the claim 1 of Application No. 10/027,138.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/247,026. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between claim 1 of the instant invention and claim 1 of Application No. 10/247,026 are as follows:

1. A process for the production of an aromatic polycarbonate, comprising the steps:

- (a) preparing a polycarbonate having free terminal OH groups by a melt transesterification process from an aromatic dihydroxy compound and a carbonic acid diester;
- (b) adding to the polycarbonate having free terminal OH groups, a sufficient amount of an end-capping agent of the following formula for capping the free terminal —OH groups of the polycarbonate, thereby forming a polycarbonate with an increased level of capped or blocked hydroxy groups:



wherein R₁ is a methoxy, ethoxy, propoxy, butoxy, phenyl, phenoxy, benzyl, or benzyloxy and R₂ is selected from the group consisting of C₁-C₃₀ alkyl, C₁-C₃₀ alkoxy, C₆-C₃₀ aryl, C₆-C₃₀ aryloxy, C₇-C₃₀ aralkyl, and C₆-C₃₀ aralkyloxy.

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The relationship between the Application No. 10/247,026 and the current invention is the genus and the species; for example, claim 1 which has the value of R1 which is a methoxy, ethoxy, propoxy, butoxy, phenyl, etc is broader than that of the claim 1 of the instant invention which has only the value of R1 which is a propoxy, butoxy.

The rest of the dependent claims are almost identical or rearranged and therefore, do not distinguish the applications. The instantly claimed genus of R1 is, thus, completely encompassed by that of the claim 1 of Application No. 10/247,026, thereby being obvious over that of the claim 1 of Application No. 10/247,026.


This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Taylor Victor Oh, MSD, LAC
Primary Examiner
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 12/10/06